

REMARKS

This is a full and timely response to the final Office Action mailed December 23, 2008. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Telephone Conversation With Examiners

Supervisor Vu and Examiner To are thanked for the telephone conversations conducted on February 24, 2009 and February 25, 2009. Because Examiner Paliwal was on vacation until March 21, 2009, Applicants' representative asked Supervisor Vu if someone were available with whom a telephone interview could be conducted. Supervisor Vu contacted Examiner To, who contacted Applicants' representative. Examiner To suggested, for the sake of consistency, to submit the instant response by the 3-month shortened statutory date of March 23, 2009, and request an interview with Examiner Paliwal upon his return.

Accordingly, Examiner Paliwal is requested, upon his return, to call Applicants' representative to schedule a telephonic interview.

Present Status of Patent Application

Claims 1, 2, 6-12, 14, 17-27, and 29-34 are pending in the present application. Specifically, claims 11, 18-22, 24, 27, 29, and 30 are original unamended claims; claims 1, 2, 6, 7, 9, 12, 17, and 23 have been currently amended without introduction of new matter; claims 8, 10, 14, 25, 26, and 31-34 have been previously presented; and claims 3-5, 13, 15, 16 and 28 are canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Claim Rejections under 35 U.S.C. §101

Statement of the Rejection

Claims 23-27 and 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Response to the Rejection

Without disclaimer or prejudice, applicants have amended independent claim 23 to specify that the system comprises a processor and that the parser is implemented on the processor. Applicants respectfully submit that the rejection of claim 23 (as well as dependent claims 24-27 and 29-30) has been overcome as a result of the amendment, and hereby request withdrawal of the rejection under 35 U.S.C. 101 followed by allowance of these claims.

Claim Rejections under 35 U.S.C. §102

Statement of the Rejection

Claims 1, 2, 6-10, 12-14, 17-21, 23-17(27), and 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by England et al. (US 6,330,670 B1), hereinafter "England".

Response to the Rejection

Claim 1

Applicants have opted to currently amend claim 1 in order to move forward prosecution in the case and also to emphasize the fact that the claim is directed at generating a vendor-provided manifest that governs the execution of a software object distributed by the vendor.

It must be recognized that such a manifest is controlled and defined by a vendor who wishes to distribute his software with protection defined by the vendor, rather than depending on security features defined by an operating system inside a customer's computer or a security mechanism provided by a third-party.

In line with the latter approach, the cited reference of England teaches an operating system (DRMOS 205) that enforces security in a customer's computer by using a rights manager certificate 210 (a third-party certificate such as a digital certificate listing the name of application, properties of the application etc.) for establishing trust in an application that is run in the customer's computer.

The software provider transmits content 221 together with a license 223 (that places restrictions on the use of the content by a trusted application in the customer's computer), and an

access predicate 222 (that specifies the properties that an application must have in order to process the content).

To further elaborate, England's rights manager certificate 210 is used to ensure that application 209 can be trusted. In England's words (col. 8, line 66 to col. 9, line 3): "*The first requirement is met in the exemplary embodiment of the invention by having all trusted operating system-level components digitally signed by their developers or a trusted third-party, with the signature acting as a guarantee that the components respect digital rights.*" Furthermore, as explained in his col. 9, lines 16-18, England points out that: "*trusted application 209 has agreed to operate in accordance with the limitations placed on content by a provider.*" While the rights manager certificate 210 ensures trust in the application 209, *the limitations placed on content (221) by a provider* (i.e., equivalent to Applicants' "manifest" provided by a vendor) is outlined by England's license 223 and access predicate 222.

Consequently, one of ordinary skill in the art will recognize that England's license 223 or access predicate 222, may be the most suitable elements to examine (vis-à-vis Applicants' "manifest") for purposes of carrying out a rejection under 35 U.S.C. 102. However, the Office action has opted to improperly equate Applicants' "manifest" to England's "rights manager certificate" 210 in carrying out the rejection (page 4 of the Office action states: "*generating a manifest (see, Column 9, lines 16-19, "rights manager certificate")*").

This impropriety has been further compounded by overlooking the fact that Applicants' claim 1 is directed at "generating a manifest" and not at "operating" the manifest. Consequently, even assuming *arguendo* that England's rights manager certificate 210 does indeed anticipate Applicants' manifest as alleged in the Office action, the rejection should explain as to how the generation of England's rights manager certificate 210 anticipates the generation of Applicants' manifest. The Office action fails to do so. Furthermore, the Office action fails to indicate where in England can be found the generation of a manifest containing "one or more rules" and a "list of unacceptable modules."

Additionally, it may be pertinent to point out that neither England's rights manager certificate 210 nor his access predicate 222 and license 223 provide a list of unacceptable modules (as incorporated in Applicants' claim 1).

In this matter, it can be appreciated that the act of disallowing all untrusted/unacceptable modules (irrespective of their identity) from being executed on a customer's computer (as taught in England) does not reasonably anticipate the act of disallowing explicitly identified unacceptable modules (as cited in Applicants' claim 1 as well as in dependent claims 31-34).

In summary, Applicants respectfully point out that the current rejection of claim 1 is improper for at least the following reasons:

- 1) the rejection improperly equates England's "rights manager certificate 210" to Applicants' "manifest"
- 2) none of England's elements indicate "a list of unacceptable modules"
- 3) the claim is directed to a method of generating a manifest (in contrast to operating/executing the manifest) – the rejection fails to recognize this fact
- 4) the manifest is generated by the vendor of the software content (England's "rights manager certificate 210" is provided by a subscriber in subscriber computer 200)

Consequently, Applicants respectfully submit that claim 1 (at least as amended) is allowable over England and hereby request withdrawal of the rejection followed by allowance of the claim.

Claims 2, 6-10, 31 and 32

Applicants respectfully assert that claims 2, 6-10, 31 and 32 are allowable for several reasons. One amongst these several reasons arises from the fact that claims 2 and 6-10 are allowable as a matter of law arising from direct or indirect dependency on allowable independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, for at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of claims 2, 6-10, 31 and 32.

Claim 12

In rejecting Applicants' claim 12, the Office action alleges on page 8 that "*generating a*

manifest based on at least one of the accessed objects (see, Column 9, lines 16-29, “rights manager certificate”)”. As pointed out above, England’s “rights manager certificate” does not reasonably equate to (or anticipate) Applicants’ “manifest.”

Nonetheless, Applicants have opted to currently amend claim 12 in order to move forward prosecution in the case and also to emphasize the fact that the claim is directed at generating a vendor-provided manifest that governs the execution of a software object distributed by the vendor. The amended claim recites identification of an executable module that may not be loaded into an address space wherein the software object is executed. As pointed out above, the cited art of England fails to reasonably anticipate the act of disallowing the execution of an explicitly identified unacceptable module.

Consequently, Applicants respectfully submit that claim 12 (at least as amended) is allowable over England and hereby request withdrawal of the rejection followed by allowance of the claim.

Claims 13

Applicants have opted to cancel claim 13 and respectfully submit that the rejection of this claim has been rendered moot as a result of the cancellation.

Claims 14, 33 and 34

Applicants respectfully assert that claims 14, 33 and 34 are allowable for at least the reason that these claims are dependent on allowable claim 12 and are consequently allowable as a matter of law. Therefore, Applicants respectfully request withdrawal of the rejection followed by allowance of claims 14, 33 and 34.

Claim 17

As is known, a proper rejection under 35 U.S.C. §102 requires that a single prior art reference disclose every element of the claim with no question of obviousness being present. Applicants respectfully submit that the current rejection of claim 17 fails to meet this requirement. For example, the Office action alleges that a portion of the claim that cites “*computing a value based on one of said one or more components and including the computed value in said manifest*” is anticipated by England’s “*Fig. 9 and also Column 9, lines 16-29*)”

However, nothing in the identified portion of England, explicitly (or even impliedly) indicates “*computing a value*” as improperly alleged in the Office action. England’s col. 9, lines 16-29 are reproduced below for easy reference:

In the exemplary embodiment shown in FIG. 2, a trusted application 209 has agreed to operate in accordance with the limitations placed on content by a provider. The trusted application 209 is identified through a "rights manager" certificate 210. In one embodiment, the rights manager certificate 210 extends a standard digital certificate, which includes such items as date of publication and name of the application, by adding a list of services, or properties, provided by the application, i.e., content type handled, version of the application, whether it saves content to disk, etc. For purposes of the exemplary embodiment shown in FIG. 2, the certificate 210 also identifies the trusted application; alternate mechanisms for identifying a trusted application are described later in the methods section.

Applicants presume that the meaning of England’s text reproduced above, as well as the labels provided in his Fig. 9, have not been expanded beyond what one of ordinary skill in the art would deem appropriate. In this regard, it may be pertinent to draw attention to MPEP 2131.01 (II. To Explain the Meaning of a Term Used in the Primary Reference), which states: Extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Emphasis added).

In light of the remarks above and for additional reasons identified above (vis-à-vis the rejection of claim 1), Applicants respectfully submit that claim 17 is allowable over England and hereby request withdrawal of the rejection followed by allowance of the claim.

Claims 18-21

Applicants respectfully assert that claims 18-21 are allowable for at least the reason that these claims are dependent on allowable claim 17 and are consequently allowable as a matter of law arising from direct or indirect dependency. Therefore, for at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of claims 18-21.

Claim 23

Applicants’ claim 23 is directed to a computer system comprising several system elements such as a parser and a manifest generator. A proper rejection under 35 U.S.C. 102

necessitates the identification of corresponding anticipatory system elements in England. However, the Office action improperly asserts that England's "rights manager certificate" anticipates Applicants' "manifest generator." Such an assertion runs contradictory to the teachings of England. One of ordinary skill in the art would not reasonably equate a rights manager certificate (a digital rights certificate for example) as a manifest generator.

The Office action further fails to disclose where in England can be found an anticipatory element for Applicants' "a manifest specification indicative of requirements for a manifest." As pointed out above, the rejection under 35 U.S.C. 102 should be carried out with no question of obviousness being present. In this case, one has to improperly assume that England incorporates a "specification" that is somehow used via a parser (not identified) for "generating" his "rights manager certificate" – the alleged "manifest".

Consequently, for at least the reasons provided above, Applicants respectfully submit that claim 23 is allowable over England and hereby request withdrawal of the rejection followed by allowance of the claim.

Claims 24-27 and 29-30

Applicants respectfully assert that claims 24-27 and 29-30 are allowable for at least the reason that these claims are dependent on allowable claim 23 and are consequently allowable as a matter of law arising from direct or indirect claim dependency. Therefore, for at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of these claims.

Claim Rejections under 35 U.S.C. §103

Statement of the Rejection

Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over England in view of Watanabe et al. (US 2002/018041 A1), hereinafter Watanabe.

Response to the Rejection

Claim 11

Applicants respectfully traverse the rejection of claim 11 for several reasons. However,

Applicants opt not to elaborate upon these reasons at this time. Nonetheless, Applicants respectfully submit that claim 11 is allowable as a matter of law arising from dependency on allowable independent claim 1. Therefore, for at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of claim 1.

Claim 22

Applicants respectfully traverse the rejection of claim 22 for several reasons. However, Applicants opt not to elaborate upon these reasons at this time. Nonetheless, Applicants respectfully submit that claim 22 is allowable as a matter of law arising from dependency on allowable independent claim 17. Therefore, for at least this reason, Applicants respectfully request withdrawal of the rejection followed by allowance of claim 22.

Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

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PATENT

CONCLUSION

Applicant respectfully submits that pending application is in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned.

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